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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,617	04/09/2004	Eric L. Gray	75028-307898	8940

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WOOD, HERRON & EVANS (ZIMMER SPINE)  
2700 CAREW TOWER  
441 VINE STREET  
CINCINNATI, OH 45202

EXAMINER
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SAN MIGUEL, ANITZA M

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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05/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/821,617

Applicant(s)

GRAY ET AL.

Examiner

Anitza M. San Miguel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

## **DETAILED ACTION**

### ***Allowable Subject Matter***

The indicated allowability of claims 5 and 7-10 are withdrawn in view of the newly discovered reference(s) to Winslow et al. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Winslow et al. (Reference U.S. Patent "5,885,299").

Winslow et al. discloses a spinal surgical instrument (100) comprising: an outer cannula (110) having a proximal end, distal end and an outer lumen passing there between (see Figure 2 below), the distal end of the outer cannula having an engagement structure (114; col. 4, lines 18-26); an inner cannula (118) having a proximal end, a distal end and an inner lumen passing there between (see Figure 2 below), the inner cannula (118) being axially moveable within the outer lumen of the outer cannula (col. 4, lines 27-39); a fixing member (132) having a proximal end and a distal end (see Figure 2 below), the fixing member (132) positioned within the inner lumen and including an arrangement (col. 4, lines 50-58).

The inner cannula (118) is axially moveable within the outer lumen of the outer cannula (110; col. 4, lines 27-31). The engagement structure (114) at the distal end of the outer cannula (110) is configured to releasably engage a locking nut. It is noted that the distal end of the cannula is capable of being configured to releasably engage a locking nut if one so desires to do so. The outer cannula (110) includes an exterior surface contour to facilitate gripping of the outer cannula (110; see Figure 1 below).

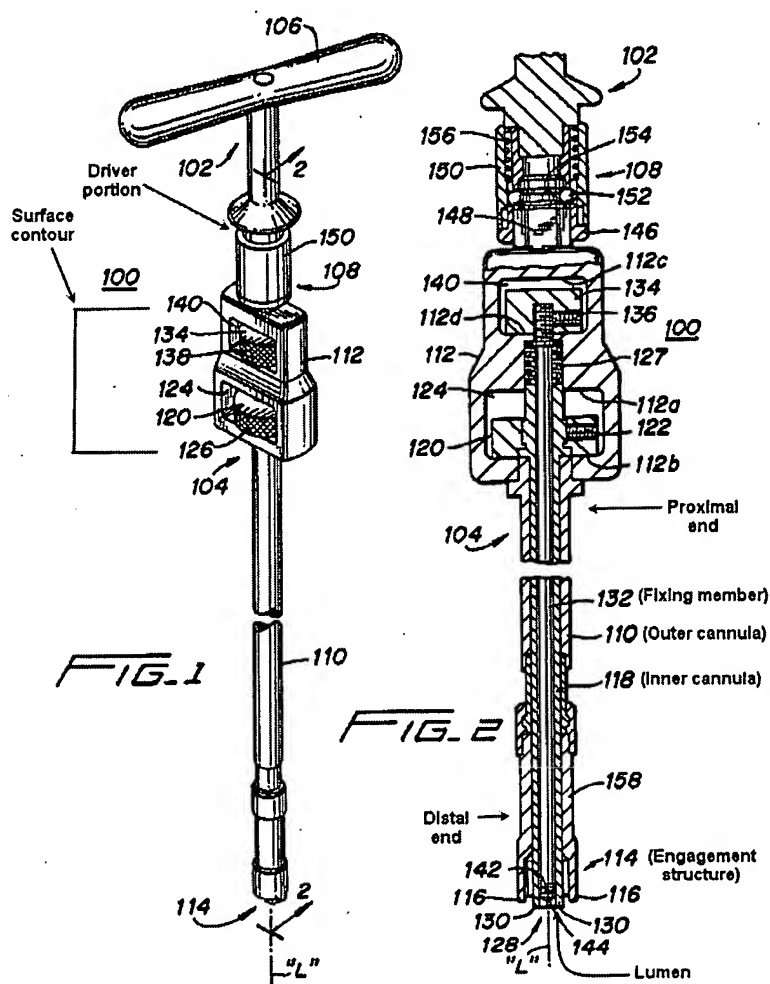
The distal end of the inner lumen includes an axially directed shoulder that can abut against a proximal end of the spinal implant (col. 4, lines 34-39). The distal end of the inner lumen includes threads for threadedly engaging a portion of the spinal implant (col. 4, lines 40-49). It is noted that the distal end of the inner lumen disclosed by Winslow has an implant engaging structure that is capable of performing the functions of the claimed invention. The spinal surgical instrument (100) further includes a driver portion (see Figure 1 below). The inner cannula including threads on an interior surface of the inner lumen; the distal end of the fixing member (132) includes exterior threads (44); and threading the exterior threads of the fixing member with the interior threads of the inner cannula provides for advancing and retracting the fixing member (132) within the inner lumen of the inner cannula (118; col. 4, lines 66-67 and col. 5, lines 1-2).

With regard to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Winslow et al. ("for advancing and retracting the fixing member within the inner lumen of the inner cannula"; "configured to engage with the exterior surface contour of the outer cannula"), which is capable of being used as claimed if one so desires to do so. *In re*

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Casey, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 7-9 rejected under 35 U.S.C. 103(a) as being unpatentable over Winslow et al. (Reference U.S. Patent "5,885,299") in view of Bryant et al. (Reference U.S. Patent "5,649,931").

Winslow et al. (herein Winslow) discloses the claimed invention except for the inner cannula including exterior threads on an exterior surface of the inner cannula, the exterior threads having a proximal end and a distal end; and the outer cannula includes interior threads within an interior surface of the outer lumen, the interior threads having a proximal end a distal end such that axial movement of the outer cannula over the inner cannula is affirmatively stopped at the first position when the proximal end of the exterior threads of the inner cannula abut against the distal end of the interior threads of the outer cannula; the inner cannula includes an exterior surface ridge on the exterior surface; the outer cannula includes a plurality of axially extending fingers at the proximal end of the cannula; and axial movement of the outer cannula over the inner cannula is affirmatively stopped at the second position when the axially extending fingers abut against the exterior surface ridge of the inner cannula;

Bryant et al. (herein Bryant) teaches to provide the inner cannula including threads (exterior surface ridge) on the exterior surface of the inner cannula; and the

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outer cannula including interior threads (plurality of axially extending fingers; col. 3, lines 5-26), in order to impart a radially inward force. It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of Winslow having the inner and outer cannula with threads on the exterior or interior surface respectively, in order to impart a radially inward force.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anitza M. San Miguel whose telephone number is 571-272-3279. The examiner can normally be reached on 8:00 am - 5:30 pm EST (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ASM

A handwritten signature in black ink, appearing to be 'ASM' followed by a stylized flourish.A large, stylized handwritten signature in black ink, possibly reading 'Eduardo C. Robert'.

EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER